

Docket S-8494 (1502-88 PCT US)

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REMARKS

Claims 1-11, 13-17, and 19-22 remain in the application, and are presented for examination and reconsideration. Claims 12 and 18 have been cancelled. Support for all amendments to the claims is found in the specification as filed, and is set forth in connection with the response to the Claim Objections and Claim Rejections under 35 USC 112, as set forth herein.

The Examiner has stated that the disclosure on page 8, lines 3-14 regarding the nature of the secondary silicone component, is unclear. It is clear from the description that Applicant contemplates using, as the secondary silicone component, any silicone that provides the lubricant composition with increased lubricant properties. Accordingly, any such silicone can be used other than one which is the same as the radiation curable silicone having epoxy pendant groups, since if the silicones were the same, there would probably be no increased lubricant properties.

At page 8, lines 3-14, there are disclosed many suitable examples of useful secondary silicones. By the present amendment, Applicant has corrected various editorial errors, at page 8, lines 11-14. For example, the materials said to be polydimethylsiloxanes are indicated properly as being "polymers" of the recited materials.

Applicant has also corrected the word "trimethoxy!" to read as "trimethoxy" at line 12. Further, the word "trimethoxysilyl" has been corrected to read as "trimethoxysilyl." Applicant also wishes to point out that the term "silicone chloride" is also known as "trichloromethylsilane."

In view of the corrections made to the specification, Applicant respectfully requests the Examiner to withdraw the objection to the disclosure of page 8, lines 3-14.

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CLAIM OBJECTIONS

The Examiner has objected to claims 5, 13, and 19 by stating that the recitation "diaryliodonium, tetrakis (pentafluorophenyl) borate salt," should be written without a comma after "diaryliodonium." This term has been amended as requested in claims 5, 13, and 19. Applicant respectfully requests this objection be withdrawn.

CLAIMS REJECTIONS UNDER 35 USC 112

(a) Claims 1-22 have been rejected, under 35 USC 112, second paragraph, as being indefinite in use of the term, "silicone-epoxy copolymer." To more clearly describe the claimed invention, Applicant has amended the claims to recite, "a silicone having epoxy pendant groups." This is supported by the disclosure on page 5 of the application as filed. Applicant respectfully requests the Examiner to withdraw this rejection of claims 1-22, under 35 USC 112, second paragraph. The appropriate amendments have been made in claims 1, 4, 7, 8, and 16.

(b) The Examiner has requested that "the secondary silicone component" be differentiated from the as-now amended term "silicone having epoxy pendant groups." To clearly differentiate the silicones, in claims 1, 8, and 16 Applicant has amended the term, "a secondary silicone component," to read, "a secondary silicone component other than a silicone having epoxy pendant groups." This has always been the intent of the claimed invention as shown on page 8. It is there disclosed that the secondary silicone component is included in the lubricant to provide increased lubricant properties. If the secondary silicone were the same as the radiation curable silicone, there is question whether there would be increased lubricant properties, as indicated. Applicant respectfully requests the Examiner to withdraw this rejection under 35 USC 112, second paragraph.

(c) The Examiner has indicated that claim 1 is unclear in describing whether the

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lubricant is a cured product. Accordingly, Applicant has amended claim 1 to recite, "a curable composition for providing a lubricant for medical devices when cured." Applicant respectfully requests the Examiner withdraw this rejection of claim 1 under 35 USC 112, second paragraph.

(d) Claim 3, 11, and 17 have been rejected as being unclear in defining the vinyl ethers. Applicant thanks the Examiner for the assistance in correcting the description of the vinyl ethers of claims 3, 11, and 17. Applicant has amended claims 3, 11, and 17, as requested. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claims 3, 11, and 17, under 35 USC 112, second paragraph.

(e) The Examiner has stated that there is lack of clarity in several terms set forth in claims 6, 14, 21, and 22. Applicant thanks the Examiner for the assistance in clarifying the secondary silicone components of claims 6, 14, 21 and 22. Applicant has amended claims 6, 14, 21, and 22, to clarify the editorial errors. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claims 6, 14, 21, and 22, under 35 USC 112, second paragraph. For the same reason, Applicant has similarly amended claim 20. Furthermore, support for insertion of polyfluorosilicones is found at page 8, line 15.

(f) The Examiner has requested clarification of claim 7 in specifying whether or not the silicone only, or the lubricant is cured. Applicant has amended claim 7 to specify that the lubricant is cured. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 7, under 35 USC 112, second paragraph.

REJECTION UNDER 35 USC 102 (b)

IN RESPECT OF U.S. 5,576,356

Claims 1-5, and 7, have been rejected under 35 USC 102 (b) as being anticipated by U.S. Patent No. 5,576,356 to Leir et al. (herein Leir). Applicant respectfully traverses this

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rejection for the following reasons.

Leir describes a radiation curable release coating composition comprising an epoxy-functional polysiloxane and a cationically co-reactive monomer copolymerizable with the epoxy group of the polysiloxane. Examples of the co-reactive monomers are shown at column 7, lines 11-37 of Leir. There is no disclosure of use of any silicone as the co-reactive monomer.

The Examiner has directed attention to Examples 31 and 32 of Leir, stating that mixtures of epoxy silicone with mercapto-functional silicone are disclosed. Applicant has carefully reviewed Examples 31 and 32, and differs with the Examiner's statement. Contrary to the Examiner's conclusion, Applicants contend that Examples 31 and 32 do not disclose a mixture of an epoxy silicone with mercapto-functional silicone. Rather, Examples 31 and 32 disclose compositions of a mercapto functional silicone (KF-2001) and CHVE, which is defined in Example 30 of Leir as cyclohexane dimethanol divinyl ether. No secondary silicone component was utilized in the release coating compositions of Example 31 and 32.

Applicant has noted that the word epoxysilicone is mentioned at column 13, line 47, of Leir. However there is nothing to indicate that the compositions of Examples 31 and 32 included epoxysilicone with the mercapto functional silane. Indeed, the compositions of Examples 31 and 32 are said, at column 13, lines 47-49, of Leir, to be found in Table III. As shown, Table III of Leir describes the compositions of Examples 31 and 32 as including KF2001 (mercapto functional silicone) and CHVE (cyclohexane dimethanol divinyl ether).

Therefore, it is apparent that Leir does not disclose all that is shown in claims 1-5, and 7, of the present application. Accordingly, claims 1-5, and 7, are not anticipated, under 35 USC 102 (b) by Leir. Applicant respectfully requests that the Examiner withdraw this rejection.

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REJECTIONS OF CLAIMS 6 UNDER 35 USC 103

The Examiner has rejected claim 6, under 35 USC 103(a), as being unpatentable over U.S. Patent No. 5,576,356 to Leir et al. (herein Leir) in view of U.S. Patent No. 6,486,267 to Bilodeau (herein Bilodeau). Applicant respectfully traverses this rejection for the following reasons.

The Examiner states that Leir does not teach adding another silicone component. Applicant agrees with the Examiner's representation of Leir, for all the reasons provided regarding the rejection under 35 USC 102(b) above.

To overcome this deficiency of Leir, the Examiner cited Bilodeau. It is said that Bilodeau teaches release compositions where compound (A) can be an epoxy silicone and (B) is a curable organopolysiloxane, such as polydimethylsiloxane. The Examiner's conclusion is that it would have been obvious to combine the teaching of Bilodeau with that of Leir, and render the present claims obvious.

Applicant has carefully reviewed Bilodeau. Applicant does not agree with the Examiner's representation of the teachings of Bilodeau. In particular, compound A is not an epoxy silicone. Compound A is described as one of two type compounds, only one of which has an epoxy group. The compound having the epoxy group, however, is not a silicone. Therefore, Bilodeau does not teach a release composition comprising an epoxy silicone and a curable organopolysiloxane. In this instance, any combination of Bilodeau with Leir, still fails to render the present claimed invention obvious.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 6, under 35 USC 103(a), over Leir in view of Bilodeau.

The Examiner has also rejected claim 6 as being unpatentable, under 35 USC 103(a),

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over Leir et al. in view of Shepherd et al. U.S. Patent No. 5,260,348, (herein Shepherd). Applicant respectfully traverses this rejection for the following reasons.

The Examiner has stated that Leir does not teach adding another silicone component. To overcome this deficiency, the Examiner has combined Shepherd with the Leir reference. It is said that Shepherd discloses compositions comprising a silanol chain-stopped polydiorganosiloxane, a crosslinking agent, and an onium salt photocatalyst.

However, Shepherd does not disclose any epoxy modified silicones. In fact, as shown in claim 1, Shepherd uses silanol chain-stopped organosiloxane polymers free of epoxy functional groups.

Applicant fails to understand on what basis one would be motivated to combine Shepherd with Leir. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection of claim 6 as being unpatentable over Leir in view of Shepherd, under 35 USC 103(a).

ALLOWABLE SUBJECT MATTER

Claims 8 and 16 have been found allowable if amended to overcome the rejections under 35 USC 112, second paragraph. The required amendments have been made, and as a result, claims 8 and 16 should be allowable.

Claims 9-11, 13-15, 17, and 19-22 have been found allowable if rewritten to overcome the rejections under 35 USC 112, second paragraph. The present amendments have overcome all rejections under 35 USC 112, and, accordingly, claims 9-11, 13-15, 17, and 19-22, should be allowable.

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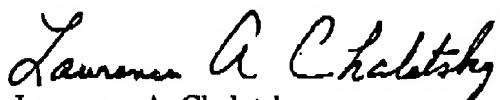
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CONCLUSION

In view of the above, Applicant believes the application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw all of the rejections and objections. Applicant submits that claims 1-11, 13-17, and 19-22, are patentable, and respectfully requests the Examiner to pass the application to issue.

Respectfully submitted,



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